

REMARKS/ARGUMENTS

Claims 1, 2, 5, 6 and 10-18 were pending in this application. No claims have been amended, added, or canceled. Hence, claims 1, 2, 5, 6 and 10-18 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,353,327 to Adari et al. (hereinafter “Adari”), in view of the cited portions of U.S. Patent No. 4,796,289 to Masor et al. (hereinafter “Masor”), and further in view of the cited portions of U.S. Patent No. 4,564,728 to Romano et al. (hereinafter “Romano”).

Claims 1-2, 10-12, 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari, and further in view of the cited portions of U.S. Patent No. 6,904,130 to Urban et al. (hereinafter “Urban”), and further in view of Romano.

Claims 5-6 and 13-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari and Urban, in view of Romano, and further in view of Applicant’s admitted prior art.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari and Urban, in view of Romano, and further in view of the cited portions of U.S. Patent No. 5,696,810 to Dunn et al. (hereinafter “Dunn”).

Claim Rejections Under 35 U.S.C. § 103(a)

The Applicant respectfully traverses the rejection of all claims rejected under 35 U.S.C. § 103(a), since the motivation asserted by the Office Action to combine Adari with Masor and/or Urban to make the Applicant’s claimed invention 1) is not found in the prior art, and 2) would not motivate one of ordinary skill in the art to make the combination.

With respect to the rejections of claims 1, 2, 5, 6, 10-16 and 18, the Office Action states that one of ordinary skill in the art would be motivated to combine Adari and Urban “to

provide a unitary test thereby reducing cost as well as spaces in the network interface.” The combination is necessary because Adari does not teach or suggest a demarcation device operable for attachment to a plurality of inside wiring nor a connection interface that provides for coupling of the demarcation device with a plurality of customer premises equipment. This motivation fails for at least the following reasons. First, the motivation does not relate to the missing limitation. Adari appears to be a unitary test, and there is no suggestion that the cost or space is a concern. Hence, the motivation does not provide a connection between limitations missing from Adari that are supposedly supplied by Urban.

Moreover, the motivation does not appear to come from the prior art; it appears to be based on facts within the personal knowledge of an employee of the Office (37 CFR 1.104(d)(2), “[w]hen a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons”). Hence, the Applicant respectfully requests an affidavit, or a citation to a prior art reference, without which the motivation is improper.

For at least the foregoing reasons, the Applicant believes claims 1, 2, 5, 6, 10-16 and 18 are allowable.

With respect to the rejection of claim 17, the Office Action relies on Masor to supply the limitation missing from Adari “disconnecting one of a plurality of inside wiring from the connection interface.” The motivation for doing so is “to test each circuit to determine whether fault exist in the CPE or service provider.” As with the combination of Adari and Urban, this motivation has no connection to the missing limitation. Adari indeed satisfies the motivation without assistance from Masor. Hence, one of ordinary skill in the art would not look to Masor based on the asserted motivation.

Moreover, the motivation again appears to be based on facts within the personal knowledge of an employee of the Office. The Applicant, therefore, requests a citation to the motivation in the prior art or an affidavit from the Examiner, as required by 37 CFR 1.104(d)(2).

For at least the foregoing reasons, the Applicant believes claim 17 to be allowable.

Conclusion

In view of the foregoing, the Applicant believes all claims now pending in this application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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